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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/930,235

02/23/1998

ANJA EITRICH

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7055 7590 05/20/2008  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

05/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 08/930,235	<b>Applicant(s)</b> EITRICH ET AL.	
	<b>Examiner</b> Daniel S. Metzmaier	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 Jan. & 03 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-17, 19, 20, 23, 24, 26, 32, 33, 35-37 and 41-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-17, 19, 20, 23, 24, 26, 32, 33, 35-37 and 41-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 12-17, 19-20, 23-24, 26, 32-33, 35-37 and 41-50 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02 January 2008 and 03 March 2008 have been entered.

#### ***Interpretation of the claims***

2. The claims set forth cosmetic compositions as transparent or translucent oil-in-water microemulsions employing O/W polyalkoxylated emulsifiers with a total emulsifier content of less than 20 %, preferably less than 10 %, most preferably less than 8 % by weight. Said microemulsions are made by employing the phase inversion temperature method of making said microemulsion. The examples are exemplary rather than comparative.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 12-17, 19-20, 23-24, 26, 32-33 and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope

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of the claims is indefinite since in claims 12 and 36, the oil phase is set forth with narrow transitional language, i.e., "consisting essentially of", and further set forth with open transitional language, i.e., "comprising".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 12-17, 19-20, 32-33, 35 and 45 are rejected under 35 U.S.C. 103(a) as obvious over McGee et al, US 5,585,343, in view of Hawley's Condensed Chemical Dictionary, entry Dibutyl Phthalate. McGee et al (examples and claim 4) disclose Low VOC perfume formulations as microemulsions for use in shower body splash.

McGee et al (claim 4; column 4, lines 48-50; and column 6, lines 1-3) discloses sodium laureth sulfate, which is a sodium lauryl ether sulfate as instantly disclosed as the polyethoxylated emulsifiers. McGee et al (column 5, line 29) clearly discloses the use of perfume oils, such as, hydrocarbons are suitable and (examples . McGee et al discloses the use of both ethylene glycol monophenyl ether and fatty alcohols in the exemplified compositions. Said materials would have been expected to have W/O emulsifier properties, i.e., a low HLB.

McGee et al differs from the claims in the oil component as claimed. To the extent McGee et al lacks a disclosure of the claimed compositions in sufficient

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specificity as claimed, McGee et al clearly contemplates the sodium laureth sulfates, hydrocarbons and fatty alcohols.

McGee et al further (column 6, lines 43-59, particularly 59) discloses the perfumes may contain non-ethanolic diluents. Hawley's Condensed Chemical Dictionary discloses dibutyl phthalate as a solvent for perfumes.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the sodium laureth sulfate for the exemplified sodium lauryl sulfate in the McGee et al reference.

To the extent McGee et al differs from the claims in the further addition of cosmetic additives to said compositions or the exemplified or disclosed compositions with sufficiency of disclosure, McGee et al clearly discloses the use of cosmetic additives, hydrocarbon perfumes and the use of alkyl ether sulfates as claimed.

McGee et al (column 7, lines 40-46) discloses cosmetic additives reading on those claimed as commonly added formulating ingredients. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ a conventional additives, hydrocarbon perfumes, and alkyl ether sulfates as taught in the McGee et al reference for their art recognized advantageous functions.

McGee et al (column 5, line 29) clearly discloses the use of perfume oils, such as, hydrocarbons are suitable. McGee et al discloses the use of both ethylene glycol monophenyl ether and fatty alcohols in the exemplified compositions. Said materials would have been expected to have W/O emulsifier properties, i.e., a low HLB.

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9. Claims 12, 16-17, 20, 23-24, 26, 20-33 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henkel KGaA, DE 4,318,171, (especially Beispiele, Tabelle 1, PIT-Emulsionen, and abstract) as evidenced by translation thereof as PTO-98-1147 and Derwent Abstract, AN 1995-014884.

Henkel KGaA (abstract) discloses finely divided emulsions made by the phase inversion temperature method of making emulsions having utility in shampoos, bath soaps, shower preparations as cosmetic emulsions. The Henkel KGaA invention is directed to processes of making said emulsions having improved properties of reduced defatting of the skin and hair.

Henkel KGaA makes their microemulsions by the same phase inversion temperature method as applicants. Henkel KGaA further characterizes the emulsions as finely divided. This microemulsion property would have been expected to be inherent in the Henkel KGaA emulsions. The characterization as transparent and translucent is a known characteristic of microemulsions.

Henkel KGaA (Table 1) disclose the use of decyl esters of oleic acids among others. Henkel KGaA (Table 1) further disclose the use of glycerol monoesters of stearic acid and cetyl/stearyl alcohols, i.e., fatty alcohols of 8-30 carbon atoms.

10. Claims 12-17, 19-20, 23-24, 26, 32-33, 35-37 and 41-50 are rejected under 35 U.S.C. 103(a) as being unpatentable Henkel KGaA, DE 4,318,171, (especially Beispiele, Tabelle 1, PIT-Emulsionen, and abstract) in view of translation thereof as PTO-98-1147, Derwent Abstract, AN 1995-014884, Rosano, US 4,146,499; with Hoppe

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et al, US 4,839,165, Unilever PLC, EP 560 516, and/or The Procter & Gamble Company (P & G), EP 616 027. Henkel KGaA disclose microemulsions as set forth in the above rejection. Said basis is incorporated herein by reference.

Henkel KGaA and Schambil et al differs from the claims in the incorporation of conventional cosmetic ingredients.

Rosano (abstract and column 1, lines 6 et seq) discloses transparent microemulsions and methods of making said microemulsions. Rosano (column 5, lines 11 et seq) discloses the microemulsions may include materials for hair conditioning and skin emollients for use in shampoos, shaving creams and hand soaps. Shaving creams are well known to contain astringents. Rosano (column 5, lines 41 et seq) further discloses the incorporation of organic solvents as conventional ingredients. Rosano (column 9, lines 6-24) discloses the conventional use of at least perfumes or dyestuff in said microemulsions.

These references are combinable since said references teach transparent (i.e., clear) microemulsions having cosmetic use. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ conventional cosmetic ingredients shown and/or implicit in the Rosano reference for their advantageous intended function known to those having ordinary skill in the cosmetic art.

To the extent the claims differ in particular emulsifiers employed, Hoppe et al (examples, particularly example 1, Akypo® RLM 150), Unilever (abstract; page 6, lines 5-8; and claims), and P & G (abstract; page 3, lines 1-10) disclose the use of alkyl ether



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sulfates or nonionic ethoxylates in combination or alternatively with alkyl ether carboxylates in cleaning and/or hair care compositions.

These references are combinable because they teach cleaning compositions and particularly hair care compositions and the surface active agents suitable therefore. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the alkyl ether carboxylates for the alkyl ether sulfates or nonionic ethoxylates as functional equivalents known in the cleaning art at the time of applicants' invention.

11. Claims 12, 16-17, 20, 23-24, 26, 20-33 and 35 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henkel KGaA, DE 4,337,041, (especially Beispiele, Tabelle 1, PIT-Emulsionen, and abstract) as evidenced by Derwent Abstract, AN 1995-171245.

12. Claims 12-17, 19-20, 23-24, 26, 32-33, 35-37 and 41-50 are rejected under 35 U.S.C. 103(a) as being unpatentable Henkel KGaA, DE 4,337,041, (especially Beispiele, Tabelle 1, PIT-Emulsionen, and abstract) as evidenced by Derwent Abstract, AN 1995-171245, Rosano, US 4,146,499; with Hoppe et al, US 4,839,165, Unilever PLC, EP 560 516, and/or The Procter & Gamble Company (P & G), EP 616 027. Henkel KGaA and Schambil et al discloses microemulsions as set forth in the above rejection. Said basis is incorporated herein by reference.

The basis for said rejection is essentially as set forth above for the related Henkel KGaA, DE 4,318,171, and Derwent Abstract, AN 1995-014884.

***Response to Arguments***

13. Applicant's arguments filed 03 March 2008 have been fully considered but they are not persuasive.

14. The arguments filed 02 January 2008 were responded to in the Advisory Action mailed 17 January 2008. Said response to said arguments is herein incorporated by reference.

15. Applicants (page 14) assert the claims are definite, contain no inconsistencies and one skilled in the art would understand the scope of the oil phase. Applicants' arguments have not been deemed persuasive since the claims are internally inconsistent regarding the scope of the oil phase by virtue of the use of intermediate transitional language followed by open transitional language defining said oil phase.

16. Applicants (pages 15 and 16) assert the examiner points out the McGee compositions contain ethylene glycol monophenyl ether and fatty alcohol and these do not qualify as components of the compositions of claim 12. Applicants' claim 23 broadly sets forth water in oil emulsifiers, which said materials would read. Furthermore, claim 16 further sets forth a wax, fat or oil. Said fatty alcohol would likewise read thereon.

17. Applicants (page 16) assert the McGee reference discloses perfume compositions, which are quite "different from a cosmetic skin or hair cleansing preparation, a cosmetic skin or hair care preparation or a deodorant preparation as recited in, e.g., present independent claim 12.". This has not been deemed persuasive since McGee (column 8, lines 5 et seq) disclose cosmetic uses that read on those claimed, e.g., deodorant.

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18. Applicants (page 16) assert that the examiner has not addressed why one of ordinary skill in the art would want to incorporate an astringent or a deterative surfactant in the perfume formulations of MCGEE. McGee (column 8, lines 5 et seq) disclose cosmetic uses including men's cologne, which commonly includes an astringent. The broadly claimed deterative surfactant is indistinct from the other emulsifiers in the compositions and thus is not a patentable distinction.

19. Applicants (pages 16 and 17) assert the amendments clearly distinguish the Henkel I reference, which discloses droplet diameters on the order of 100-300 nanometers rather than the amended range of  $10^{-2}$   $\mu\text{m}$  (10 nanometers) to  $10^{-1}$   $\mu\text{m}$  (100 nanometers). This has not been deemed persuasive since applicants range overlaps Henkel I's range and applicants range is modified by about.

20. Applicants (pages 17 and 18) assert the Henkel I emulsions comprise only a small percentage of the overall compositions. This has not been deemed persuasive since applicants' claims only refer to a maximum amount of emulsifier in the compositions and are otherwise silent on the concentrations of the remaining ingredients.

21. Applicants (pages 18 and 19) assert the secondary references to Henkel I, while showing the use of various cosmetic ingredients, does not provide motivation for their use. The KSR decision forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Please see the Board of Appeals decision *Ex parte Smith*, USPQ2d, slip op at 20, (Bd. Pat. App. & Interf. June

25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices.dcom.bpai/prec/fd071925.pdf>).

22. Applicants (page 19) assert the examiner has not identified any reason for incorporating cosmetic ingredients in the Henkel I compositions. With all due respect, the examiner has provided interpretation of the broad claims where components are anticipated and read on the broad claim language, and provided further commonly known reasons for incorporating components into the Henkel I compositions. While applicant may not agree with the examiner's *prima facie* case of anticipation or obviousness, a *prima facie* case has been set forth. Said *prima facie* case is deemed proper and has been maintained.

23. Applicants (pages 20 and 21) assert the examiner has not presented evidence of the definition of a microemulsion for Henkel II. This has not been deemed persuasive since applicants characterize microemulsions in the background on pages 1 and 2 of the instant specification and Henkel I further discusses microemulsions at page 4 of the PTO translation as noted by applicants. There appears to be sufficient documentation of microemulsions in the record for the examiner's position.

24. Applicants (page 21) assert the same arguments for Henkel II in view of the secondary references as asserted for Henkel I in view of the secondary references. These have been addressed above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Daniel S. Metzmaier/  
Primary Examiner, Art Unit 1796**

DSM